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In re Application of :
Guido Galley et al :
Serial No.: 10/767,784 : PETITION DECISION
Filed: January 29, 2004 :
Attorney Docket No.: 21453 :

This is in response to the petition under 37 CFR 1.144, filed October 26, 2006, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 and contained 24 claims, as filed. The examiner mailed to applicants on May 5, 2006, a restriction requirement, summarized as follows:

Groups I-VII – claim 1, drawn to compounds of Formula IA wherein variable C is one of 7 moieties;

Groups VIII-XIV – claim 1, drawn to compounds of Formula IB wherein variable C is one of 7 moieties;

Groups XV-XXI – claim 22, drawn to processes for preparing compounds of Formula IA wherein variable C is one of 7 moieties;

Groups XXII-XXVIII – claim 23, drawn to processes for preparing compounds of Formula IB wherein variable C is one of 7 moieties;

Groups XXIX-XXXV - claims 20-21, drawn to methods of using compounds of Formula IA wherein variable C is one of 7 moieties;

Groups XXXVI-XLII - claims 20-21, drawn to methods of using compounds of Formula IB wherein variable C is one of 7 moieties.

C is defined as one of phenyl, pyridinyl, furanyl or tetrahydrofuranyl, benzo[b]thiophenyl, tetrahydronaphthyl, indanyl, or 2,2-dimethyl-[1,3]dioxolanyl. (It is presumed that claims 2-19 are grouped with claim 1 for restriction purposes.)

The examiner set forth proper reasons for restriction between the Groups with respect to product, method of making and method of use, and advised of possible rejoinder. No specific reason for

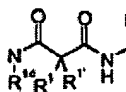
(B) subcombination claims linking plural combinations.

Where an application includes claims to distinct inventions as well as linking claims, restriction can nevertheless be required. The linking claims must be examined with, and thus are considered part of, the invention elected. When all claims directed to the elected invention are allowable, should any linking claim be allowable, the restriction requirement between the linked inventions must be withdrawn.

However, M.P.E.P. 803.02, which deals with Markush practice, is the more appropriate examiner guidance for applicants' claims wherein a Markush group is set forth:

A Markush-type claim recites alternatives in a format such as "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925). The members of the Markush group (A, B, and C in the example above) ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property. Inventions in metallurgy, refractories, ceramics, pharmacy, pharmacology and biology are most frequently claimed under the Markush formula but purely mechanical features or process steps may also be claimed by using the Markush style of claiming.

Applicants have set forth a Markush group of compounds based on Formulas IA and IB. It is noted that the only common structure in either formula is the substituted malonamide structure shown here:



Everything else is a variable. It is noted that the left side of the structure contains as a variable an -L-C group where L is a bond or short chain alkyl group and C is as defined above. The right side of the structure varies widely and includes many single and fused ring systems optionally with one or more heteroatoms. Each core malonamide structure combined with an -L-C moiety forms a proper separate and distinct Markush group. A proper Markush group is defined as: "Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature essential to that utility." Here each combination of the malonamide core with a different -L-C group forms a separate and distinct substantial structural feature in both Formula IA and IB which is presumed to be essential to the utility disclosed. (The property or activity does not appear to lie solely or primarily with the malonamide core.) Since there are seven separate structures formed a seven way restriction is appropriate. The examiner properly divided the various structures claimed according to the common malonamide core combined with variable -L-C to show the various differing significant structural elements. However, in view of the fact that both Formula IA and IB contain the same seven common cores the requirement for restriction should only have created 21 Groups, not 42.

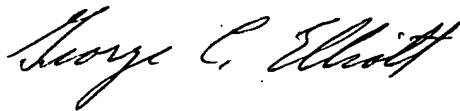
DECISION

The petition is **GRANTED-IN-PART** in that Groups VIII-XIV are combined with Groups I-VII; Groups XXII-XXVIII are combined with Groups XV-XXI; and Groups XXXVI-XLII are combined with Groups XXIX-XXXV respectively. Applicants' election of Group I applies to

both Formula IA and IB structures. Rejoinder of the appropriate method of making and method of use Groups has been indicated by the examiner.

The application will be forwarded to the examiner for consideration of the amendment filed October 26, 2006, and such action as deemed appropriate.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 703-308-3824 or by facsimile sent to the general Office facsimile number, 571-273-8300.

A handwritten signature in cursive script, reading "George C. Elliott".

George C. Elliott
Director, Technology Center 1600